

REMARKS

The Official Action of July 14, 2010, made final, and the Advisory Action of October 19, 2010, and the references cited therein have been carefully reviewed. The Applicant respectfully requests reconsideration of the application in view of the following remarks.

Claims 50-62 have been canceled without prejudice and rewritten for presentation as new Claims 63-75 for convenience in entering this amendment. The definition of R¹ from Claim 37 has been incorporated into new Claim 63. Support for this amendment is found in the Specification, e.g., page 2, line 15 to page 10, line 1, page 14, line 15 to page 19, line 11, and the claims of the application as filed. Claims 63-75 are pending in the application.

I. Rejection of Claims 36, 40 and 45 under 35 U.S.C. 102(b)

Claims 36, 40 and 45 were rejected under 35 U.S.C. 102(b) as being anticipated by Altenbach et al (US 2005/0256118). Applicants respectfully traverse this rejection and submit that Altenbach et al. does not disclose each and every element of the claimed invention. In particular, Altenbach et al. discloses an isoquinolinyl compound which bears an methyl-pyrrolidinyl-ethyl group at R¹, a methyl group at R², and a difluorophenyl group at R³. In contrast, the present claims as amended to incorporate the groups of R¹ from former Claim 37 do not possess all of these substituents together in a single embodiment. Accordingly, the rejection of Claims 36, 40 and 45 under 35 U.S.C. § 102(b) as being anticipated by Altenbach et al (US 2005/0256118) is untenable and should be withdrawn.

II. Rejection of Claims 36 and 39 under 35 U.S.C. § 112, Second paragraph

Claims 36 and 39 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. The Examiner was concerned regarding the terminology and typographical errors in these claims. Applicants respectfully assert that the claims particularly point out and distinctly claim the subject matter that they regard as their invention. In the interest of compact prosecution, however, they have amend the claims in rewriting them as new claims to incorporate the Examiner's suggestions. Accordingly, Applicants respectfully submit that the rejection of Claims 36 and 39 under 35 U.S.C. § 112, second paragraph, for indefiniteness is untenable and should be withdrawn.

III. Objection to Claims as Containing Non-Elected Subject Matter

The Examiner indicated that Claim 50 contains non-elected subject matter. Accordingly, Applicants have amended Claim 50 in rewriting it as new Claim 63 to be directed to the variable R1 as being (unsubstituted or substituted) quinolinyl or isoquinolinyl. Because the claims have been amended as requested by the Examiner to delete the quinioxaline and isoindoline possibilities for R1, Applicants respectfully submit that the claims should be in condition for allowance.

IV. Allowable Subject Matter

Applicants gratefully acknowledge that Claims 50-53 and 58 are objected to as being dependent upon a rejected base claim, and that Claims 54-57 and 59-62 are allowable. In this regard, the limitations of Claim 37 have been incorporated into the main independent Claim 50. Accordingly, in view of the foregoing amendments and remarks, such claims should be allowed.

Applicants respectfully contend that the application is allowable and a favorable response from the Examiner is earnestly solicited.

Respectfully submitted,

By J. Eric Thies, Reg.# 35382/
J. Eric Thies
Reg. No. 35,382
Attorney for Applicant
MERCK
P.O. Box 2000
Rahway, New Jersey 07065-0907
(732) 594-3904

Date: November 2, 2010